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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,117	08/23/2001	Craig L. Ogg	42159/SAH/S850	2154

23363 7590 03/09/2006

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EXAMINER
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BASS, JON M

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/938,117	<b>Applicant(s)</b> OGG, CRAIG L.	
	<b>Examiner</b> Jon Bass	<b>Art Unit</b> 3639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**Status of Claims**

1. Claims 1, 4, 5, 8-12 are pending in this application. Claims 2,3,6 and 7 have been deleted. Claims 1,5,9 and 11 have been amended.

**Response to Amendment**

2. Objections that were made, directed to the drawings, have been withdrawn due to the proper correction made to the specification.

3. Regarding the 35 USC 101 rejection, Due to the decision made by the Board of Appeals in Ex parte Lundgren, the rejection has been withdrawn.

4. Amendments to the Specification have been reviewed and acknowledged.

5. Applicant argues that, in regard to claim 1, that the prior art Herbert fails to teach "A postage indicium fraud detection method for permitting the automated processing of void mail pieces bearing an unique indicium, comprising:

printing a first unique indicium on a mail piece or a label to be applied to a mail piece, the first unique indicium

comprising at least one of a unique facing identification marking (FIM) different from FIM A, FIM B and FIM C, and a unique postal numeric encoding technique (POSTNET) barcode that does not correspond to an actual zip code, which first unique indicium identifies the mail piece as being a void mail piece and is sorted from mail pieces not bearing the unique indicium by automated mail handling equipment". The Examiner has incorporated additional prior art by Perry Pierce (EP 0927956 A2) to further explain the Facing Identification Mark (FIM). Pierce further explains on {page 2, 0007}, that the host produces the mail piece front including the return address, the delivery address, the Facing Identification Marking (FIM), and the indicium as an integral unit. The host also produces standardized addresses; including standard POSTNET delivery points bar codes. The Examiner would like to include that the combination of Herbert and Piece combine to emulate an invention that is fully functional of printing a unique indicium on a mail piece comprising at least one Facing Identification Markings (FIM). However the Examiner submits that the rejection is based on the conglomerate of the two references Herbert and Piece, where as Piece discloses at least one Facing Identification Marking (FIM). In addition, The Examiner would also like to note that the same rejections apply to the other independent claims.

6. In regard to Claim 5, The Applicant argues that the prior art fails to teach "processing the void mail piece bearing the first unique indicium with the automated mail handling equipment to identify and segregate the void mail piece from other non-void mail pieces". The Examiner respectfully disagrees with the characterization of the inventive concept. Herbert teaches on page 3, lines 18-23 that ink which rendered invisible by burst of light for printing the postage indicia, the imprint of the postage indicia in light responsive ink may be of a form and so located as to obscure at least a part of an imprint of marking printed in normal ink indicating that the mail item is void.

7. In regard to Claim 9, The Applicant argues that the prior art fails to teach "A postage indicium fraud detection method for permitting the automated processing and segregation of void mail pieces bearing a first unique indicium from non-void mail pieces not bearing the first unique indicium, comprising:

providing client software which permits a user to print information based indicia postage onto a mail piece or label for a mail piece;

having the user enter a valid delivery address, select a type of mail piece, mail class, attributes, and special services;

having the user verify and accept the address and any modifications thereto;

having the user select between printing a sample void information based indicia postage and a non-void information based postage indicia;

having a user print a sample information based postage indicia for void mail pieces and printing non-void information based postage indicia for non-void mail pieces wherein the void mail piece or a label therefore is printed with a first unique indicium comprising at least one of a unique facing identification marking (FIM) different from FIM A, FIM B, and FIM C, and a unique postal numeric encoding technique (POSTNET) barcode that does not correspond to an actual zip code, which first unique indicium identifies the mail piece as a void mail piece;

and providing automated mail handling equipment which is adapted to segregate void information based postage indicia bearing mail pieces from non-void information based postage indicia bearing mail pieces". The Examiner notes that Herbert does disclose "providing client software which permits a user

information based indicia postage onto a mail piece or label for a mail piece". Herbert discloses in column 1, lines 10-36 that accounting functions in respect of the required postage charge and prints a postage indicium on the mail item. Also in taught in column 5, lines 38-40. This demonstrates that the accounting functions done were using a computer, which has client software. According to the definition of client software, it's merely an application that's run on a computer system.

8. The arguments that were provided by the applicant have been considered but are not persuasive due to the set forth above.

9. The Applicant is reminded to contact the Examiner Bass if any questions arise. The Examiner hours of operation are Monday-Friday 9-6pm.

10. Below is the updated Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 9, and 11** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**In regard to claim 9**, "providing client software which permits a user to print information", presents a situation that is unclear due to the particular terminology provide. The Examiner would like to suggest, "authorizing client software for a user to print information based indicia postage onto a mail piece or label for a mail piece". The new terminology acknowledges the focus point on the claim presented.

**In regard to claim 9**, there is uncertainty whether "having the user enter" refers to instructions or user options. The Examiner would like to suggest considering the terminology, "entering a valid delivery address, selecting a type of mail piece, mail class, attributes and special services by a user". In addition, the applicant discloses, "having the user verify", again, the Examiner would like to suggest modifying the claim language to "accepting the address and any modification thereto". In addition, "selecting between printing a sample void



information based indicia postage and a non-void information based postage indicia".

**In regard to claim 9**, the applicant presented the following language, " having a user print a sample information based postage indicia for void mail piece and printing non-void information..." The Examiner notes that the claim language used directs the claim in the direction of presenting the user the option of being able to print or generalizing that the software presents asking the user a question directed toward the printing of the sample information. The Examiner suggest that the language used be alter to "printing a sample information based postage indicia for void mail piece and printing non-void information..." This terminology acknowledges that the user is fully capable of printing the sample information based postage indicia for void mail pieces.

Once the changes are made, a more clearly defined claim unfolds.

**In regard to claim 11**, the applicant uses the claim language "providing automated mail handling". This language could suggest giving the user an option or demonstrate a method in which mail is handled. The Examiner would suggest removing the term providing and beginning as such "sorting mail based on

indicia placed on mail pieces using automated mail handling equipment". In addition using the following language "printing a first unique indicia on a mail piece or a label to be applied to a mail piece the first unique indicium comprising at least one of a unique facing identification marking (FIM) different from FIM A, FIM B and FIM C, and a unique postal numeric encoding technique (POSTNET) barcode that does not correspond to an actual zip code using the provided software".

Once the changes are made, a more clearly defined claim unfolds.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Raymond Herbert (US Patent Number

6,102,592), hereinafter referenced as Herbert in view of Perry Pierce (European Patent Application, EP 0927956); referred to as Pierce.

**As Per Claim 1:**

Herbert discloses a postage indicium fraud detection method for permitting the automated processing of void mail pieces bearing an unique indicium, and which first unique indicium identifies the mail piece as being a void mail piece and is sorted from mail pieces not bearing the unique indicium by automated mail handling equipment.

[{col.3, lines 30-32}, void mark can be obscure by a modified postage indicia shown in Figure 4, the mail item is imprinted with the void mark], comprising:

However Herbert fails to explicitly explain: printing a first unique indicium on a mail piece or a label to be applied to a mail piece, the first unique indicium comprising at least one of a unique facing identification marking (FIM) different from FIM A, FIM B and FIM C, and a unique postal numeric encoding technique (POSTNET) barcode that does not correspond to an actual zip code,

Nevertheless, Pierce discloses on page 2, 0007, that a host produces the mail piece front including the return address,

delivery address, and the facing identification marking (FIM), including POSTNET delivery point bar code. Pierce further explains that the host may print this unit on the actual mail piece.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Herbert's method in conjunction with Pierce method to emulate an invention that deals with permitting automated processing of void mail pieces that has printing FIM corresponding to an actual zip code. Herbert's motivation to modify this invention to entail FIM pertaining to zip code would allow fraud to be detected.

**As Per Claim 4:**

Herbert discloses a method for The postage indicium fraud detection method wherein an additional indicium comprising a unique postal alpha numeric encoding technology barcode is printed onto the mail piece or label for the mail piece, which unique postal alpha numeric encoding technology barcode is used to at least one of identify the sender of the void mail piece, the time of the void mail handling, and collect statistics on attempts to mail void mail pieces by the sender, [fig 5]; illustrates a postage meter with two printing stations and fig

1, 10, 11, 12}}; bears destination information and postage indicium printed].

**As Per Claim 5:**

Herbert discloses a postage indicium fraud detection method for permitting the automated processing of void mail pieces bearing an unique indicium, and which first unique indicium identifies the mail piece as being a void mail piece and is sorted from mail pieces not bearing the unique indicium by automated mail handling equipment.

[{col.3, lines 30-32}, void mark can be obscure by a modified postage indicia shown in Figure 4, the mail item is imprinted with the void mark], comprising:

However Herbert fails to explicitly explain: printing a first unique indicium on a mail piece or a label to be applied to a mail piece, the first unique indicium comprising at least one of a unique facing identification marking (FIM) different from FIM A, FIM B and FIM C, and a unique postal numeric encoding technique (POSTNET) barcode that does not correspond to an actual zip code,

Nevertheless, Pierce discloses on page 2, 0007, that a host produces the mail piece front including the return address, delivery address, and the facing identification marking (FIM),

including POSTNET delivery point bar code. Pierce further explains that the host may print this unit on the actual mail piece.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Herbert's method in conjunction with Pierce method to emulate an invention that deals with permitting automated processing of void mail pieces that has printing FIM corresponding to an actual zip code. Herbert's motivation to modify this invention to entail FIM pertaining to zip code would allow fraud to be detected.

**As Per Claim 8:**

Herbert discloses a method for The postage indicium fraud detection method wherein the first unique indicium comprises a unique postal numeric encoding technique barcode which is used by automated mail handling equipment to segregate void mail pieces bearing the unique postage numeric encoding technique barcode from mail pieces not bearing the unique postage numeric encoding technique barcode, [fig 5]; illustrates a postage meter with twp printing stations and {fig 1, 10, 11, 12}; bears destination information and postage indicium printed].

**As Per Claim 9:**

Herbert discloses a postage indicium fraud detection method for permitting the automated processing of void mail pieces bearing an unique indicium, and which first unique indicium identifies the mail piece as being a void mail piece and is sorted from mail pieces not bearing the unique indicium by automated mail handling equipment.

[{col.3, lines 30-32}, void mark can be obscure by a modified postage indicia shown in Figure 4, the mail item is imprinted with the void mark], comprising:

However Herbert fails to explicitly explain: printing a first unique indicium on a mail piece or a label to be applied to a mail piece, the first unique indicium comprising at least one of a unique facing identification marking (FIM) different from FIM A, FIM B and FIM C, and a unique postal numeric encoding technique (POSTNET) barcode that does not correspond to an actual zip code,

Nevertheless, Pierce discloses on page 2, 0007, that a host produces the mail piece front including the return address, delivery address, and the facing identification marking (FIM), including POSTNET delivery point bar code. Pierce further explains that the host may print this unit on the actual mail piece.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Herbert's method in conjunction with Pierce method to emulate an invention that deals with permitting automated processing of void mail pieces that has printing FIM corresponding to an actual zip code. Herbert's motivation to modify this invention to entail FIM pertaining to zip code would allow fraud to be detected.

**As Per Claim 10:**

Herbert discloses a method for The postage indicium fraud detection method wherein the first unique indicium comprises a unique postal numeric encoding technique barcode which is used by automated mail handling equipment to segregate void mail pieces bearing the unique postage numeric encoding technique barcode from mail pieces not bearing the unique postage numeric encoding technique barcode, [{{fig 5}; illustrates a postage meter with twp printing stations and {fig 1, 10, 11, 12}; bears destination information and postage indicium printed].

**As Per Claim 11:**

Herbert discloses a postage indicium fraud detection method for permitting the automated processing of void mail pieces



bearing an unique indicium, and which first unique indicium identifies the mail piece as being a void mail piece and is sorted from mail pieces not bearing the unique indicium by automated mail handling equipment.

[{col.3, lines 30-32}, void mark can be obscure by a modified postage indicia shown in Figure 4, the mail item is imprinted with the void mark], comprising:

However Herbert fails to explicitly explain: printing a first unique indicium on a mail piece or a label to be applied to a mail piece, the first unique indicium comprising at least one of a unique facing identification marking (FIM) different from FIM A, FIM B and FIM C, and a unique postal numeric encoding technique (POSTNET) barcode that does not correspond to an actual zip code,

Nevertheless, Pierce discloses on page 2, 0007, that a host produces the mail piece front including the return address, delivery address, and the facing identification marking (FIM), including POSTNET delivery point bar code. Pierce further explains that the host may print this unit on the actual mail piece.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Herbert's method in conjunction with Pierce method to emulate an

invention that deals with permitting automated processing of void mail pieces that has printing FIM corresponding to an actual zip code. Herbert's motivation to modify this invention to entail FIM pertaining to zip code would allow fraud to be detected.

**As Per Claim 12:**

Herbert discloses a method for the postage indicium fraud detection method wherein an additional indicium comprising a unique postal alpha numeric encoding technology barcode is printed onto the mail piece or label for the mail piece, which unique postal alpha numeric encoding technology barcode is used to at least one of identify the sender of the void mail piece, the time of the void mail handling, and collect statistics on attempts to mail void mail pieces by the sender, [fig 5]; illustrates a postage meter with two printing stations and {fig 1, 10, 11, 12}; bears destination information and postage indicium printed].

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any concerns in regard to this communication, the examiner **Jon Bass** can be reached at **(571) 272-6905** between the hours of **9-6pm Monday through Friday**. The fax number for the establishment where the application is being process is **(571) 273-8300**.

If an attempt to reach the examiner is unsuccessful for any reason, the examiner's immediate supervisor, **John Hayes** can be reached at **(571) 272-6708**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

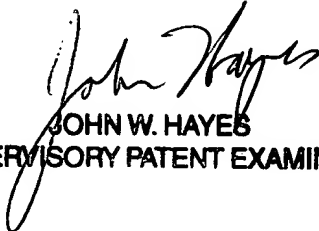
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**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

C/O Technology Center 3600

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**JOHN W. HAYES**  
**SUPERVISORY PATENT EXAMINER**